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EXAMINER

MATTISON, LORI K

ART UNIT

PAPER NUMBER

1619

NOTIFICATION DATE

DELIVERY MODE

05/18/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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REQUEST FOR RECONSIDERATION/OTHER

Box 11: In the traverse of the rejection over PANTINI and CHEETHAM, Applicant alleges that the stability of PANTINI pertains to emulsion stability, that PATINI is completely silent with regard to polyphenols, oxidative degradation, and that CHEETHAM only discloses caffeic acid and derivatives as sunscreen additives, (Reply, page 9, paragraphs 8 and 9; page 10, paragraph 2). Applicant alleges that PATINI describes composition which could be used for several treatments, compositions, and protection of skin against sun radiations (Reply, page 10, paragraph 3). Thus, Applicant alleges that a person of ordinary skill in the art would not know to what of the many compositions described by PATININI to add the teachings of CHEETHAM to in order to sustain prima facie case of obviousness (Reply, page 10, paragraph 3). Applicant alleges that a person of ordinary skill would not know to which of the many uses described by PATINI to add the caffeic acid described by CHEETHAM because there is no motivation to add caffeic acid to obtain advantageous UV absorption in a deodorant or nail varnish removal and that the Examiner has utilized impermissible hindsight (Reply page 10, last paragraph). Applicant alleges that comment that the Applicant has recognized another advantage which would flow from the suggestion of the prior art is erroneous and that none of the cited references provide a hint of suggestion or motivation to combine the caffeic acid of CHEETHAM with the polyether phosphates of PATINI (Reply, page 11, paragraphs 1-3).

Applicant's traverse has been considered but is not persuasive. With regard to Applicant's traverse that PATINI is silent with regard to polyphenols, that CHEETHAM only discloses caffeic acid and derivatives as sunscreen additives, and that there would be no hint of suggestion or motivation to combine the caffeic acid of CHEETHAM with PATINI, PATINI

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explicitly teaches a cosmetic formulation which is a suncream (page 10, paragraphs 77-78). PATINI teaches inclusion of sun filters in the compositions of his invention (paragraph 30). CHEETHAM explicitly teaches that caffeic acid (a polyphenol) has *advantageous* UV absorption qualities; CHEETHAM even *embodies* use of caffeic acid (i.e. polyphenols) in a *sunscreening composition* (CHEETHAM, column 12, lines 30-55). Thus, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the invention was made, to have added caffeic acid (i.e. polyphenols) to the sunscreening composition taught by PATINI because caffeic acid (i.e. polyphenols) are *advantageous* UV absorbers utilized in sunscreening compositions.

With regard to Applicant's allegation that one of ordinary skill in the art would not have known to which composition of PATINI in which to add the caffeic acid (i.e. polyphenols) to in order to sustain *prima facie* case of obviousness, Applicant is reminded that PATINI explicitly teaches use of sun filters in the protective gels of his invention and embodies a suncream gel with the UV absorber octylmethoxycinnamate (paragraphs 30, and 77-78). As such, the artisan of ordinary skill with in the art would be quite clear as to where the caffeic acid (i.e. polyphenols) may be applied (i.e. any composition which embodies use of a UV absorber like the suncream composition and any composition of PATINI which is a gel as taught and embodied by PATINI).

With regard to Applicant allegation that a person of ordinary skill would not know to which of the many uses described by PATINI to add the caffeic acid of CHEETHAM to due to there being no motivation to add caffeic acid to obtain advantageous UV absorption in a deodorant or nail varnish removal, that none of the cited references provide a hint of suggestion

or motivation to combine the caffeic acid of CHEETHAM with the polyether phosphates of PATINI, and that the Examiner has utilized impermissible hindsight (Reply page 10, last paragraph). Applicant is again reminded of PATINI's direction to utilize sun filtering agents in the protective gels (paragraph 30). With regard to Applicant's allegation that there is no motivation to add caffeic acid to nail varnish removal compositions or deodorants, Applicant is reminded that the instant rejection is based on an embodied sunscreen which comprises an emulsion gel and comprises the UV absorber, octylmethoxycinnamate. Furthermore, caffeic acid (i.e. a polyphenol) was recognized as being an *advantageous* UV absorber and caffeic acid's use was embodied in suncreening composition in CHEETHAM. Thus, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). With regard to Applicant's allegation that none of the cited references provide a hint of suggestion or motivation to combine the caffeic acid of CHEETHAM with the polyether phosphates of PATINI, the recognition of the prior art that caffeic acid (i.e. a polyphenol) was an *advantageous* UV absorber and its embodiment in a suncreening composition provides sufficient motivation and teachings to the artisan of ordinary skill in the art to utilize caffeic acid in sunscreens because it was known to be an *advantageous* UV absorber. With regard to Applicant's allegation that the comment by the Examiner that the Applicant has recognized

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another advantage which would flow from the suggestion of the prior art is erroneous, it is observed that Applicant does not state why the statement the statement is erroneous. While Applicant may allege that the PATINI does not discuss the need to prevent oxidative degradation or polyphenols degradation, PATINI already *embodied* use of the perfluoropolyether phosphate (FOMBLIN) in the suncream and required it to be the base composition (abstract, paragraph 77 and 78). As discussed above, caffeic acid was known by the artisan of ordinary skill as an advantageous UV absorber for use in sunscreens as taught by CHEETHAM. M.P.E.P. § 2145 states, "*Prima facie* obviousness is not rebutted by merely recognizing additional advantages or latent priorities in the prior art." In the instant case the "stabilizing polyphenols against oxidative degradation" is a latent property attributed to the perfluoropolyether phosphate (see claim 16, line 3) and PATINI explicitly requires the perfluoropolyether phosphate in the base invention of the prior art and embodies its use in suncreams (abstract; paragraphs 77 and 78). The latent property is flowing *through* inclusion of the perfluoropolyether phosphate. Thus, the Examiner's statement is not erroneous as alleged.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORI MATTISON whose telephone number is (571)270-5866. The examiner can normally be reached on 8am-6pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DAVID BLANCHARD can be reached on (571)272-0827. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/LORI MATTISON/

Examiner, Art Unit 1619

/Joanne Hama/

Primary Examiner, Art Unit 1632